

medium be applied to the coated surface of the transparency is clearly disclosed throughout the specification, for example, at page 11 lines 13 through 25.

Brooker discloses and requires that the image applied by his method be "printed onto a non-absorbent medium," such as the "smooth back side of a transparency sheet," rather than the coated front side of a transparency sheet as is required by claim 20 of the present invention. See abstract, and Column 4 lines 58 through 64, (*"The transparency film made for ink type printers, hereinafter called 'ink transparency film' having a solution on one surface cannot be used in this process unless the smooth, back side is used, contrary to instructions on the transparency package which warns against reversing the transparencies."*). Brooker cannot, therefore anticipate claim 20.

The rejection of claims 1-10, 13-15 and 20-23 as being obvious over Brooker in view of US patent number 4,770,732 to Steelman is traversed.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2142. As discussed above with regard to claim 20, Brooker does not teach or suggest - and in fact expressly teaches away from - the limitation of both claims 1 and 20 that requires applying a first layer of waterfast medium to a surface of an ink-jet transparency sheet, with the surface of the transparency to which the first layer of waterfast medium is applied having a coating adapted to receive hydrophilic solvent-based ink, to thereby create an image on said transparency sheet. Brooker standing alone cannot therefore render claims 1 and 20 or any claims depending therefrom obvious. *In re Fine*, 837 F.2d107, 1076 (Fed. Cir. 1988)(Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.).

The combination of Steelman and Brooker, as suggested by the Examiner, does not suggest or disclose all of the limitations of claims 1 or 20, and cannot therefor render obvious either of claims 1 and 20, or any claims depending therefrom. As discussed at page 5 lines 5 through 28 of the present application, Steelman does not disclose or suggest applying an image to a coated sheet, but

rather creates an image on an uncoated substrate by applying a coating in the form of graphics, with the material used for the graphics including a matrix resin, a binder resin, and a light altering agent. The coating is solidified, and then wetted to at least partially dissolve the binder in the graphic. Therefore, the combination of Steelman and Brooker fails to teach or suggest application of an image to a coated surface of an ink-jet transparency as is required by the present invention.

Applicant further notes that there is no suggestion within Brooker or Steelman for making the combination suggested by the Examiner. The combination suggested is therefore impermissible hind-sight reconstruction of Applicant's invention, and cannot render claims 1, 20, or any claims depending therefrom obvious.

The Examiner's Objection to claim 20 as being a substantial duplicate of claim 1 is traversed.

Claim 1 includes additional limitations that are not required by claim 20, and which add further patentable distinctions over the prior art. Claims 1 and 20 are not, therefore, substantial duplicates but rather allowable claims of varying breadth.

Claim 20 is directed to a method for creating an image adapted for transfer to a display surface of a substrate. The method of claim 20 comprises applying a first layer of waterfast medium to a surface of an ink-jet transparency sheet having a coating adapted to receive hydrophilic solvent-based ink to create an image on said transparency sheet, with the first layer of waterfast medium being applied to the coated surface of the ink-jet transparency sheet. As discussed above, the prior art does not disclose, teach or suggest, inter alia, creating an image for transfer to a substrate by applying a first layer of waterfast medium to a coated surface of an ink-jet transparency sheet, and cannot therefore form a basis for rejection of claim 20.


Claim 1 requires, inter alia, additional steps as compared to claim 20, of: at least partially liquifying the image and coating on the ink-jet transparency sheet with a solvent; placing the surface of the ink-jet transparency having the at least partially liquified image and coating in intimate contact with a display surface of a

substrate for a time sufficient to transfer a portion of the image and coating from the transparency sheet to said substrate; and peeling away said transparency sheet, to thereby create an art object. The prior art does not disclose, teach or suggest these additional steps. These steps therefore add patentable distinction over and above any limitations of claim 20 having similarity to limitations of claim 1, to such an extent that claim 20 cannot be said to be a substantial duplicate of claim 1.

Applicant believes that no fee is occasioned by submission of this paper. If a fee is occasioned by submission of this paper, however, applicant requests that the Commissioner contact Applicant's Counsel, and the required fee will be provided.

Reconsideration and allowance of the application as now presented are requested.

Respectfully submitted,
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